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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,902	02/25/2005	Kazuhiro Yagishita	CU-4101 RJS	9193
26530 7590 01/14/2009 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER GOLOBY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
01/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,902

Applicant(s)

YAGISHITA, KAZUHIRO

Examiner

James Goloboy

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7-10 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-10, 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 10/10/08 fails to distinguish claims 1, 5, 7-10, and 16 over the art of record. The rejections of those claims set forth in the previous office actions are maintained below. Newly added claims 17-18 are also rejected.

Claim Rejections - 35 USC § 103

2. Claims 1, 5, 7, 9-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert and Shanklin.

The rationale for the rejections of claims 1, 5, 7, 9-10 and 16 is adequately set forth in paragraph 4 of the office action mailed 6/11/08, which is incorporated here by reference.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert and Shanklin as applied to claims 1, 5, 7, 9-10, and 16 above, and further in view of Curtis.

The rationale for this rejection is adequately set forth in paragraph 5 of the office action mailed 6/11/08, which is incorporated here by reference.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert and Shanklin as applied to claims 1 above, and further in view of 1, 5, 7, 9-10, and 16, and further in view of Igarashi (U.S. Pat. No. 5,912,212).

The discussions of Robson in paragraph 2 above and the previous office actions are incorporated here by reference. Robson, Emert, and Shanklin disclose a composition meeting the limitations of claim 1, and including an antioxidant which can be an ester of (3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid (column 71 lines 53-58 of Emert). Robson, Emert, and Shanklin do not disclose the specific antioxidant of claim 17.

Igarashi, from column 2 line 5 through column 3 line 35, discloses a lubricant composition which can contain a phenolic compound (column 2 line 37 through column 3 line 34). In column 25 lines 57-59, Igarashi discloses that octyl (3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid, as recited in claim 17, is a suitable phenolic additive.

It would have been obvious to one of ordinary skill in the art to include the phenolic additive of Igarashi as the phenolic antioxidant of Robson, Emert, and Shanklin, as Igarashi teaches that it is a suitable additive for lubricants.

5. Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Shanklin and Papay (U.S. Pat. No. 5,652,201).

The discussions of Robson and Shanklin in the above paragraphs and previous office actions are incorporated here by reference. The differences between Robson and Shanklin and the currently presented claims are:

i) Robson discloses in paragraph 124 that the composition can further contain an antioxidant, but does not specifically disclose ashless antioxidants, nor does Robson disclose the composition of antioxidant. This relates to component (B) of claim 1.

ii) Robson also discloses in paragraph 134 that the composition can comprise a dispersant, but does not specifically disclose ashless dispersants, nor does Robson disclose the concentration of dispersant. This related to component (D) of claims 1 and 18.

With respect to i), Papay discloses in column 41 lines 52-59 the addition of 0.05 to 0.7% of ashless amine or hindered phenolic antioxidant to a lubricating composition, within the range recited for component (B) of claim 1.

With respect to ii), Papay discloses in column 13 line 49-55 boron-free dispersants for lubricating compositions, and in columns 15-18 teaches succinimide dispersants. In column 15 lines 62-64 Papay teaches that the preferred substituent for the succinic acylating agent is a polyisobutenyl group, as recited in claim 18. The dispersants of Papay therefore meet the limitations of claims 1 and 18. In columns 44-45 Papay teaches similar dispersants, which are phosphorus-free as well as boron-free. It is also noted that Papay discloses in columns 37-40 that the composition contains a boron-containing additive, similar to that of Robson.

It would have been obvious to one of ordinary skill in the art to include the antioxidants and dispersants of Papay in the composition of Robson and Shanklin, in order to prevent oxidative degradation of the lubricating oil, and to prevent the formation of deposits.

Response to Arguments

6. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive. Applicant argues that Robson teaches only a borated dispersant, while the claims have been amended to require a non-borated dispersant. However, paragraph 134 of Robson, as cited in the previous office action, teaches the inclusion of "dispersants *other than those mentioned*" (emphasis added). Robson therefore clearly provides for the addition of non-borated dispersants, such as those of Emert.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797